

REMARKS

The Examiner rejected Claims 4 and 9 under 35 U.S.C. 103(a) as being unpatentable over Ohtomo (US 6,093,928) in view of Bouldin (US 4,463,089). Applicant traverses this rejection.

Basically, the Examiner argues that Ohtomo shows the invention as claimed in Claim 4 with the exception of the limitation that the code strip carrier includes a reflective medium having a reflectivity that is altered by exposing the medium to light of an intensity greater than a predetermined intensity. The Examiner looks to Figures 1 and 2 of Bouldin for the missing teachings. According to the Examiner, Bouldin teaches a "code strip carrier" having the recited properties. The Examiner goes on to argue that one of ordinary skill would be motivated to utilize the reflective medium in Bouldin because it would achieve high resolution optical data storage.

First, Applicant must point out that Bouldin does not use the term code strip carrier; this is the Examiner's characterization of disk 11 taught in Bouldin based on the present application. Such hindsight reconstruction is not permitted in constructing a rejection under 35 U.S.C. 103. Bouldin teaches a conventional write once optical data disk of the type used for DVD or CD disks. The Examiner has not pointed to any teaching that the recording medium in question is useful in any form of encoder application.

Second, the Examiner's motivation for altering the teachings of Ohtomo to include the medium of Bouldin assumes that the device of Ohtomo stores data and that the amount of data stored would be increased by using the medium of Bouldin. The Examiner has not pointed to any teaching in either reference that would support these assumptions. The outer track taught in Ohtomo is a series of dark and light stripes having equal spacing, and hence, does not store data in the sense that the device taught in Bouldin. "The mere fact that a reference could be modified to produce the patented invention would not make the modification obvious unless it is suggested by the prior art." (*Libbey-Owens-Ford v. BOC Group*, 4 USPQ 2d 1097, 1103). "When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference" (*In re Rijckaert*, 28 USPQ2d, 1955, 1957). Hence, Applicants

respectfully submit that the Examiner has not made a *prima facie* case for obviousness with respect to Claims 4 and 9.

The Examiner stated that Claims 1-2, 5-7 and 10 are allowed.

I hereby certify that this paper is being sent by FAX to 571-273-8300.

Respectfully Submitted,



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